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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/674,174
Filing Date: September 29, 2003
Appellant(s): WOOD ET AL.

Kevin W. Raasch
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief 12 June 2007 appealing from the Office action mailed 10 October 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(8) Evidence Relied Upon

EP 0 669 121 A1	Roessler, Thomas Harold	12-1994
US 5,656,111	Dilnik et al.	08-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 7-15 and 29-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Document EP 0 669 121 A1 (EP '121) in view of Dilnik et al. (US 5,656,111).

EP '121 discloses a closure system comprises a base tab (90), a carrier tab (44), a fastener component (C. 20, L. 36-58), an overlap region and a bonding tape (74). The base tab comprises an outer edge (80) and first and second major surfaces (Figs. 1-3). The carrier tab comprises first and second major surfaces, an inner edge (50) and an opposing outer edge (108). The inner edge and the outer edge define a length of the carrier tab (Figs. 1-3). The fastener component is attached to at least one of the first and second major surfaces of the carrier tab (C. 20, L. 36-58). The overlap region in which a portion of the first major surface of the carrier tab faces the second major surface of the base tab such that the outer edge of the base tab is located between the inner and outer edges of the carrier tab (Figs. 1-3). The bonding tape is adhesively attached to the second major surface of the base tab adjacent the overlap region (Figs. 1-3). The bonding tape is further adhesive positioned or welded to the second major surface of the carrier tab within the overlap region (C. 18, L. 5-10). The inner edge of the carrier tab is located between the bonding tape and the second major surface of the base tab (Figs. 1-3).

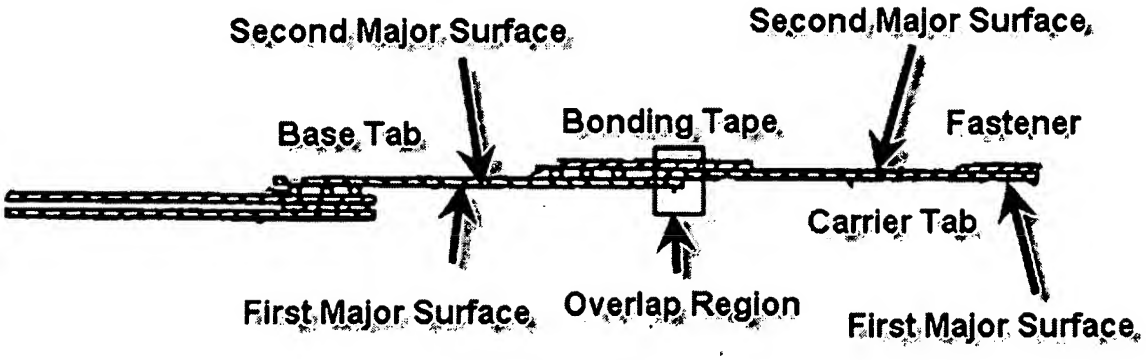

FIG. 3

EP '121 fails to disclose that the bonding tape is adhesively attached and welded to the major surface of the carrier tab with the overlap region. However, Dilnik teaches a closure system comprises a carrier tab (10), a fastener component (18) and a bonding tape (26). The carrier tab comprises an outer edge (14) and a major surface (Fig. 4B). The fastener component is attached to the major surface of the carrier tab (Fig. 4B). The bonding tape is adhesively attached between the carrier tab and the fastener component (Figs. 4B). The bonding tape is further adhesive attached and welded to the carrier tab and the fastener component (C. 6, L. 18-23 and C. 7, L. 29-62). The use of adhesive and welding to join the carrier tab to the fastener component produce a system that possesses good shear adhesion and good peel adhesion (C. 7, L. 39-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to have a bonding tape that is further adhesively attached and welded as taught by Dilnik for the bonding tape that joins the base tab to the carrier tab for the closure system disclosed by EP '121 especially since EP '121 disclose the use of

both systems to join the carrier tab to the bases tab and the system will possess good shear adhesion and good peel adhesion as taught by Dilnik.

No adhesive is located between the first major surface of the carrier tab and the second major surface of the base tab within the overlap region (Fig. 3).

At least a portion of the base tab exhibits elasticity (C. 16, L. 30-43).

The bonding tape comprises a layer of pressure sensitive adhesive facing the base tab and the carrier tab (C. 23, L. 31-58).

The carrier tab is inelastic (C. 21,L. 9-23).

The bonding tape is inelastic (C. 23, L. 31-58).

The base tab comprises an integral portion of a disposable garment (Fig. 1).

The fastener component is adhesively attached to the carrier tab (C. 20, L. 36-58).

The fastener component comprises a mechanical fastener component (C. 20, L. 36-58).

The bonding tape is coextensive with a width of the carrier tab as measured transverse to the length of the carrier tape (Figs. 1-3).

The fastener component is coextensive with a width of the carrier tab as measured transverse to the length of the carrier tape (Figs. 1-3).

Regarding claim 15, a combination of rejected claims 1, 3, 6, 8 and 9 will serve to reject claim 15 since claim 15 combines the limitations of all of the aforementioned claims.

The first major surface of the carrier tab and the second major surface of the base tab are not attached to each other within the overlap region (Figs. 1-3).

For claim 31, the same rejection of claim 15 serves to reject claim 31 since the base tab has at least a portion of the base tab that exhibits elasticity (C. 16, 30-43).

Regarding claim 43, a combination of rejected claims 1, 3, 6, 8, 9 and 29 will serve to reject claim 43 since claim 43 combines the limitations of all of the aforementioned claims.

For claim 44, the same rejection of claim 1 serves to reject claim 44 since the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

(10) Response to Argument

Claims 29-43

The Applicant argues that EP '121 and Dilnik fail to disclose that "the first major surface of the carrier tab and the second major surface of the base tab are not attached to each other within the overlap region". The Applicant makes reference to column 22 , line 27 to column 24, line14 with special emphasis to lines 6-14 of column 24 to support his position since these lines recite a Y-bond that and a Y-bond will require an attachment between the first major surface of the carrier tab and the second major surface of the base tab are not attached to each other within the overlap region as part of the bond. This argument fails to persuade. The Examiner understands that lines 6-14 of column 24 recite that there is a Y-bond formed between the carrier tab, the base tab and the bonding tape and that such a bond implies that there is an attachment

between the first major surface of the carrier tab and the second major surface of the base tab are not attached to each other within the overlap region. However, the Examiner fails to agree that such a Y-bond is required for all the embodiments disclosed by EP '121. Lines 37-41 recite "In the illustrated embodiment, release tape 74 is positioned in a superposed, adjacent relation with substrate member 48, and is attached to an interior surface of diaper 20." These lines disclose that the bonding tape (release tape 74) is positioned in a superposed, adjacent relation with the carrier tape (substrate member 48) and is attached to an interior surface of the diaper 20 (base tab) as shown in Figures 2 and 3. The attachment between these component is present even in those instances where there is no overlapping between the carrier tab and the base tab contrary to the Applicant's argument in line 3-19 of the Appeal brief. These lines support the rejection to the claims because they do no recite that there is an attachment between the first major surface of the carrier tab and the second major surface of the base tab within the overlap region and there is no requirement for a Y-bond. With respect to the Y-bond, lines 1-14 of column 24 recite "In a particular embodiment of the invention, a terminal end portion of release tape 74 may optionally overlap and adhesively bond to an intermediate section of substrate member 48 along a bond region which traverses across the length of the substrate member. The resultant interconnection between substrate member 48 and release tape 74 provides for a Y-bond which can strengthen the assembly and attachment of tape fastener 44 to the section of diaper 20 that is clamped between release tape 74 and factory-bond region 50 of tape substrate member 48. In other aspects of the invention, release tape 74 can

be constructed and configured to provide for stress beam section 98." The Examiner has underlined the most relevant part of this citation since the Y-bond being disclosed in lines 1-14 of column 24 is not required for all the embodiments presenting an overlap region between the first major surface of the carrier tab and the second major surface of the base tab (as shown in Figures 2 and 3) but rather is an optional embodiment where the Y-bond will strengthen the bond.

Claims 1-3, 7-15, 29 and 30

In response to applicant's argument that the claim limitation a "bonding tape adhesively positioned and welded to the second major surface of the base tab adjacent to the overlap region" is different from the bonding tape taught by Dilnik because "the adhesive is provided merely to hold the bonding tape in position until the weld providing the attachment can be made. The weld provides permanent attachment of the bonding tape to the base tab and the carrier tab" as recited in lines 19 to 21 of page 11 of the Appeal Brief, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, Dilnik discloses a bonding tape that is attached by using an adhesive layer and a thermal bond where both attachment means play a role in the positioning and attachment just as recited in the claims. The differences between the method being disclosed by Dilnik and the method being disclosed by the current application are irrelevant to the patentability of these

claims because the method of forming the device is not germane to the issue of patentability of the device itself especially when the article limitations are met (in view of the teachings of Dilnik). Therefore, the limitation directed to the method of forming has not been given patentable weight.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the secondary reference suggests that the combination of a bonding tape adhesively positioned and welded provides a strong bond that also possesses good shear adhesion and a good peel. Additionally, the proper analysis of obviousness is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. Factors other than the disclosure of the cited prior art may be a basis for concluding that it would have been obvious to one of ordinary skill in the art to bridge the gap. KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1742, 82 USPQ2d 1385, 1394 (2007).

Claim 44

The Applicant argues that the method limitations should be given patentable weight since the claim should be read as a whole. This argument fails to persuade since Dilnik teaches a bonding tape that is "adhesively attached and welded". Therefore, the method of forming the device is not germane to the issue of patentability of the device itself especially when the article limitations are met (in view of the teachings of Dilnik). Therefore, the limitation directed to the method of forming has not been given patentable weight.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/RCR/ Ruth C. Rodriguez

Ruth C. Rodriguez

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